

EXHIBIT F

First Office Action (9 pages)



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

07/736,071 07/25/91 KIGHT

P 1761100-7500

EXAMINER

HAYES, G

ATTN: PATRICIA E. LANIER, C.L.A.
PORTER, WRIGHT, MORRIS & ARTHUR
41 SOUTH HIGH ST.
COLUMBUS, OH 43215

ART UNIT	PAPER NUMBER
----------	--------------

2311

4

DATE MAILED: 11/04/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|-----------------------------------------------------------------------------------------|----------------------------------------------------------------------------------|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-28 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-22, 25-27 are rejected.
5. ☒ Claims 23-24 & 28 are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Serial No. 07/736071
Art Unit 2311

-2-

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. Applicant has not given a post office address anywhere in the application papers as required by 37 C.F.R. § 1.33(a). A statement over applicant's signature providing a complete post office address is required.
3. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-22 and 26 are rejected under 35 U.S.C. § 103 as being unpatentable over Shavit or Pronto.

Shavit discloses use of a centralized system 50 for interconnecting various sellers, buyers, service providers, and financial institutions to allow for interactive on-line communications between and processing of business related transactio for the various parties. The Shavit system includes a

Serial No. 07/736071
Art Unit 2311

-3-

payment service means which allows a user identified as a buyer, distributor, supplier, service provider, etc. to authorize central system 50 to carry payment instructions to the payor's bank. Thus, Shavit discloses means for inputting and storing as recited in claim 1 as well as means for electronic access and means for paying. The invention as recited in claim 1 differs from Shavit system as discussed above in that means for defining and storing mathematical interrelationships is recited. However, Shavit in column 8 lines 64-66 allows for a payee to update his credit data. The Examiner respectfully asserts that it would have been obvious to one skilled in the art that credit data based on payment or commitments of intent to pay from one party to another would involve some mathematical manipulations interrelating the parties. Claim 1 is rejected.

The article by Robert Wilumstad discloses a home banking system implemented by Chemical Bank known as Pronto Electronic Banking. The system involves use of a personal computer to perform traditional banking services including transfer of funds, check balancing, payment of bills, etc. Performance of these functions involves remote access to Chemical's computer through use of the personal computer. See page 42.

Use of accountants or trustees to manage the financial affairs of individuals or entities is well known in arts involving financial management. The Examiner respectfully asserts that one user of the Pronto system could be such a trustee or accountant.

Serial No. 07/736071
Art Unit 2311

-4-

If the use is an accountant or trustee, then the personal computer used to access Chemical Bank would include means to input and store the account data including the institution at which such accounts are held as well as data identifying those entities to whom the client owes money. Means for balancing monies owed against funds available are a well known part of financial management programs. Therefore means for defining and storing mathematical interrelationships relating to stored consumer and debtor data exists in the prior art. As the balancing feature is used in financial management programs to pay bills, the Examiner asserts that one skilled in the art would have been motivated to include such a feature in Pronto which is also used to pay bills. Pronto enables means for enabling the service provider, in this case the user of Pronto to make payment to those parties owed.

The invention as recited in claim 1 differs from use of Pronto by an accountant as discussed above in that means for the consumer to electronically access the system for paying bills from a remote location in order to instruct the provider of this service to pay bills is explicitly recited in claim 1. The Examiner respectfully asserts that this language is so broad as to cover use of a personal computer by the accountant's clients to communicate with the accountant through a modem. If such a method of communication is used the data would be transferred from the client's computer to that of the accountant. The accountant's computer would therefore be accessed electronically by that of his client. Motivation for

Serial No. 07/736071
Art Unit 2311

-5-

client and the accountant to communicate is evident since the accountant needs the relevant data to perform its function.

Claim 1 is rejected.

Claims 2-3 recite use of separate data bases to store data relating to the financial institution used and data relating to merchants. The Examiner respectfully asserts that it would have been obvious for one skilled in the art to index data by client (in the case of the Pronto system) or by subscriber (in the case of the Shavit system) since all data stored for paying bills relates to this entity. It would further have been obvious that data could be should be indexed by the debtor. In the case of the Shavit system the system operators would wish to pull all data (credits, debits, purchase data etc.) relating to this entity at once in order to have complete subscriber records available. In the case of accountants, the Examiner respectfully asserts that the accountant would wish to be able to retrieve all data relating to the entity. Claims 4-6 recited three well known means of transferring funds to parties owed by the debtor. The Examiner respectfully asserts that absent some disclosure of the criticality of this particular feature, once the idea of paying bills as advanced by the traditional functions of accountants in combination with the Pronto system and by Shavit is known, the choice of which well known means to do so is a design choice and does not create a patentable difference. Claims 4-6 are rejected.

Claims 7-8 recite use of a touch tone telephone and of a

Serial No. 07/736071
Art Unit 2311

-6-

computer to terminal as access means. The Examiner respectfully asserts that as disclosed by Pronto and Shavit use of a personal computer to allow a user to access a remotely located computer system is well known. Use of a telephone to provide access means is also well known. Claims 7-8 are rejected.

Steps of inputting and storing as recited in claim 9 correspond to means performing the same functions as recited in claim 1. The invention as recited in claim 9 differs from a method claim corresponding to apparatus claim 1 in that a step of analyzing risks to the service provider in paying the consumer's bills to determine the preferred form of payment is recited. The Examiner respectfully asserts that the accountant and those who implement the Shavit system (i.e., service provider) would be motivated by the need to avoid lawsuits and the desire to maintain a good relationship with clients to analyze the risks she would face if her client's bills are not paid by the required due date. She would then choose the form of payment she preferred which would allow bills to be paid in the most efficient manner. Thus, motivation exists for the accountant to analyze the due dates, and funds available in order to choose the form of payment she preferred and to arrange for payment of the bill through use of the form of payment. Claim 9 is rejected.

Claim 10 recites use of routing transit numbers and customer account numbers. The Examiner respectfully asserts that if electronic transfer of funds is used to pay bills then this

Serial No. 07/736071
Art Unit 2311

-7-

information would have to be used to identify the client's bank and account in held at that bank. Claim 10 is rejected.

If checks are to be mailed, then the billing entities name and address are necessary. In addition, this data would normally be provided to the accountant by her client. Finally, if the client is a merchant then the account number associated with that client is a merchant account number. Claim 11 is rejected.

Claims 12-16 recited steps analogous to means recited in claims 4-8 and are rejected on the same basis.

The Examiner respectfully asserts that the language of claim 17 is so broad as to include any means which allows the user to verify that the debtor has sufficient funds to cover the debt since rumors that the accountant could not properly handle her clients funds would be bad for business. One such means would be that which checks the account balance prior to disbursing funds to creditors. Claim 17 is rejected.

Claim 18 includes input of banking and merchant data which is addressed in the rejection of claims 2-3; provision of a request for service as recited in claims 7 and 15; a step of analyzing as recited in claim 9; payment of bills by means or steps recited in claims 4-6 and 13-15.

Claim 19 recites subject matter found in claims 2-3 and 7. The invention as recited in claim 19 also includes a program to analyze consumer instructions and means to effect bill payments regardless of the particular identity of the service provider. The

Serial No. 07/736071
Art Unit 2311

-8-

Examiner respectfully asserts that language of claim 19 is so broad as to include input of data received by the accountant into the Pronto system which would then analyze client account data to pay bills. This data as discussed previously could be received by the accountant through use of a modem arrangement. Further, such language would include an interface written to ask the client including users of the Shavit system for input of certain specified data needed for bill payments and input of this data to Pronto automatically. Motivation to use such an interface is to avoid the need to enter data to Pronto manually. Finally, as noted in the discussion of claim 1, the service provider could be an accountant (an entity who would normally perform a function of paying bills for clients). Claim 19 is rejected.

Claim 20 recites subject matter found in claim 7 and is rejected on the same basis.

The front end processor of Chemical bank and computer 50 of Shavit meet the limitations found in claim 21.

Determination of credit risks are discussed in column 9 line 7-43 of Shavit. Claim 22 is rejected.

Division of expenses into fixed and variable categories is a standard technique of financial management. Claim 26 is rejected.

3. Claim 27 is rejected under 35 U.S.C. § 103 as being unpatentable over Pronto or Shavit as applied to claim 19 above, and further in view of MYTE MIKE Business System.

MYTE MIKE is a software accounting system which includes means

Serial No. 07/736071
Art Unit 2311

-9-

for automatically determinating due dates. One skilled in the art would have been motivated to make use of such financial management program since a traditional function of an accountant is to pay her client's bills. Claim 27 is rejected.

4. Claims 23-24 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

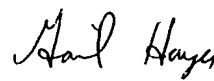
5.

-REMARKS-

The Examiner is also aware of a service provided by the makers of TurboTax, ChipSoft, which allows users to arrange for payment of bills by a third party. If additional data can be obtained about this service, copies will be forwarded to Applicant.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gail Hayes whose telephone number is (703) 308-1670.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0754.


GAIL O. HAYES
PRIMARY EXAMINER
GROUP 2300

g.o.h.
November 2, 1992